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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/635,449	08/10/2000	Kimiya Yamaashi	NIP189	6477

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MATTINGLY, STANGER & MALUR, P.C.
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SUITE 370
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EXAMINER

RAMOS FELICIANO, ELISEO

ART UNIT	PAPER NUMBER
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2681

DATE MAILED: 05/06/2003

6

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
09/635,449

Applicant(s)
YAMAASHI et al.

Examiner
ELISEO RAMOS-FELICIANO

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on _____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- *See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 2 6) ☐ Other:

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DETAILED ACTION

Priority

1. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Information Disclosure Statement

2. The references listed in the Information Disclosure Statements filed on August 10, 2000 have been considered by the examiner (see attached PTO-1449 form).

Title

3. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.
4. The following title is suggested: *Digital broadcasting system for providing program and data to a vehicle.*

Abstract

5. The abstract of the disclosure is objected to because in line 11, recites "the broadcasting station 104", which should be --the broadcasting station 101--. Correction is required. See MPEP § 608.01(b).

Claim Objections

6. **Claim 5** is objected to because of the following informalities: the claim reads "aid" in the second line, which appear to be a typographical error for --said--. Correction is required.

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7. **Claim 20** is objected to under 37 CFR 1.759(c) as being in improper form because a multiple dependent claim should refer to other claims in the alternative only. See MPEP § 608.01(n). Accordingly, the claim has not been further treated on the merits.

8. **Claim 21** is objected to because of the following informalities: the recitation "said cipher key is obtained from an IC card for a mobile terminal as a cipher key" (emphasis added) introduce redundancy. Correction is required.

Claim Rejections - 35 USC § 112

9. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

10. **Claims 7-14, 17 and 19-20** are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

11. **Claim 8** recites the limitation "said transmission means" in the second line. However, *claim 7* recites "a transmission means", while *claim 1* also recites "a transmission means", both of which appear to be distinct. Therefore, it is unclear which one of the "transmission means" is recalled by *claim 8*. There is unclear antecedent basis for this limitation in the claim. On the same token, the "transmission means" recited at least in **claim 7**, should be particularly distinguished from that of *claim 1*; for example, by use of an expression such as --second transmission means--.

12. **Claims 9, 14 and 19** contain a recitation in parenthesis. This render the claim(s) indefinite because it is unclear whether the limitation(s) in parenthesis are within the scope of the claim(s)

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and, therefore, part of the claimed invention. Recitations in parenthesis are not active limitations; therefore, no patentable weight is given to the same.

13. **Claims 10-12** recite the limitation "said information service station" in the second line.

There is insufficient antecedent basis for this limitation in the claim(s) due to the reasons explained for *claim 9* above.

14. Regarding **claim 13**, the phrase "such as" renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention. See MPEP § 2173.05(d).

15. **Claim 20** recites the limitation "a cipher key described in claim 8" in the third line. There is insufficient antecedent basis for this limitation in the claim.

16. **Claim 17** recites the limitation "said designated memory media" in the last line. There is insufficient antecedent basis for this limitation in the claim.

17. **Claims 18-24** are rejected as failing to define the invention in the manner required by 35 U.S.C. 112, second paragraph.

The claims are narrative in form and replete with indefinite and functional or operational language. The structure which goes to make up the device must be clearly and positively specified. The structure must be organized and correlated in such a manner as to present a complete operative device.

It is not clear whether or not the applicant is claiming a station or a process. The claims will be treated as better understood.

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18. The claims are generally narrative and indefinite, failing to conform with current U.S. practice. They appear to be a literal translation into English from a foreign document and are replete with grammatical and idiomatic errors.

Claim Rejections - 35 USC § 102

19. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371© of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

20. **Claims 1-14 and 17** are rejected under 35 U.S.C. 102(e) as being anticipated by Hollenberg (US Patent Number 6,091,956).

Regarding **claim 1**, Hollenberg discloses a digital broadcasting system that includes a digital broadcasting transmission apparatus (elements 14 and 32; Figures 1, 3, 5) for broadcasting data groups (elements 3 and 29; Figures 2, 4, 6, 11, and 12) and a digital broadcasting receive apparatus (elements 18 and 19; Figures 1, 3, 5) (device 2; Figures 2, 4, 6, 11) for receiving the

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data groups directly or indirectly through a data distribution part (elements 30 and 36; Figures 1, 3, 5). See column 21, line 30 to column 23, line 8; column 11, lines 23-26, column 12, lines 1-5, and column 18, lines 40 & 61, *inter alia*.

The digital information (data groups) originates from a global communications network (element 31; Figures 1, 3, 5) that includes "services such as electronic mail, entertainment, games, news, television, particularly digital TV, and access to other networks, including the Internet, for example" (column 7, lines 41-46).

The digital broadcasting transmission apparatus has a transmission means (e.g. 32) for multiplexing and broadcasting ordinary data (e.g. digital information described above) to be broadcasted as present programs and index data defined as identification of data broadcasted in past or to be broadcasted in future, as depicted in the display (4) the broadcasting receive apparatus (2) exhibited in Figures 2, 4, 6, 11 and as illustrated in Figure 12. See column 21, line 30 to column 22, line 42.

Regarding **claims 2-8**, Hollenberg discloses everything claimed as applied above (see *claim 1*). In addition, "the item's symbol, icon, or name is capable of being included with other items in a executably selectable menu which appears to pop up, that is, to quickly graphically appear adjacent to the icon or text item which was executably selected by the user, on the user's computer display, whether it is to be included in the map displayed on user's computer, and, if displayed, whether the item's symbol, which may be a standard display symbol which is resident in memory, including storage, on user's device, or the item name can be subsequently selected by a

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user to automatically provide additional information about the item, such as by enlarging the detail, called zooming in, or, for example, as hypertext, in which the item name or symbol can be selected or clicked on by a user to provide additional information. Data type 29d also includes executable code for animated icons or avatars (graphic elements which represent their users in such a display). Concise code such as mappable code 29 is particularly suited to low bandwidth information communication systems such as those which might be found in large areas. After connection with the local information service provider, the user's location and look ahead request, initiated by selecting look ahead icon 8f in FIG. 6, are communicated to the service provider which responds by sending the appropriate information. Device 2g receives mappable hypertext code for each item to be represented on the display, such as items 3m, 3n, 3p, 3q, and main roads" (column 22, lines 16-42). See also column 25, lines 13-31.

From above, the index data includes a data ID and a remote location from which the data can be downloaded (e.g. URL / address). See column 21, line 30 to column 22, line 42; and Figure 12. Distinctive identifiers are added to the ordinary data and the index data.

As to the digital broadcasting receive apparatus, data separation means are inherent in view of the fact that data is transmitted differently as explained above. As to judge means, reference is made to Figure 2, 4, 6, and 11. As the user travels from one location to another, the data being displayed is updated from an original data to an updated data; this process inherently includes judge means as claimed. See the abstract, and column 21, line 30 to column 23, line 8, *inter alia*. See also column 25, lines 13-31.

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As illustrated by Figures 1, 3, and 5 the digital broadcasting receive apparatus is a mobile terminal (e.g. 18, 19), and includes download request means for allowing to select (click) the necessity for downloading by displaying index data (hypertext) of an original data not downloaded yet (additional information): "as hypertext, in which the item name or symbol can be selected or clicked on by a user to provide additional information" (column 22, lines 28-30). The mobile terminal further includes both transmission means for transmitting the download request and receive means for receiving the contents in response thereto. An ID and password (public-key) for uniquely identifying the requesting terminal is used for the purpose of receiving back the additional information; see column 23, line 24, *inter alia*.

Regarding **claims 9-12**, Hollenberg discloses everything claimed as applied above (see *claim 1*). In addition, the digital broadcasting receiver may be characterized as an information relay apparatus or information service station. It includes a data receive means for receiving the digital broadcasting contents, and a data memory means for storing the received data groups; see column 20, line 57, column 22, lines 34-44, and column 27, lines 51-59. As to the rest of the limitations, in view of 112 rejection above, as better understood, the digital broadcasting receiver, information relay apparatus, or information service station is met by Hollenberg as explained in the rejection of *claims 2-8* above which is incorporated herein.

Regarding **claim 13**, Hollenberg discloses a mobile terminal (2; 18, 19) embedding a computer executing plural installed software programs such as map navigation, as depicted in Figures 1-6 and 10-11. The mobile terminal (2) includes communication means (14) for receiving

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digital broadcasting contents, input means (e.g. touch-screen 4a-4d) for accepting an operation input by a user: "hypertext, in which the item name or symbol can be selected or clicked on by a user to provide additional information" (column 22, lines 28-30). The mobile terminal (2) also includes information memory means for storing programs and related data, display means (4) for displaying an execution result of programs and a operation screen; and control means (controller) for managing a program data captured from the communication means and the input means. The information memory means stores management information including information ID of the programs and independent data; see Figure 12; abstract; column 7, lines 41-46, column 12, lines 13-40 column 18, lines 20-67, column 19, lines 9-14, column 20, lines 54-60, column 21, line 29 to column 23, line 40, and column 25, lines 10-30.

Regarding **claims 14 and 17**, Hollenberg discloses everything claimed as applied above (see *claim 13*). In addition, the mobile terminal's control means receives the broadcast multiplexed data. The data includes several components, such as those depicted in Figure 12, including an ID (number or name). The "user selects which of an optional plurality of visit lists to begin downloading" (column 25, lines 13-15). "Mappable hypertext items, may be executably selected by user to provide additional information or execute as computer code" (column 13, lines 36-38). The "hypertext, in which the item name or symbol can be selected or clicked on by a user to provide additional information" (column 22, lines 28-30). The communication means has a receive channel corresponding to a transmission from a download requester as well as a receive channel for the digital broadcasting.

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Claim Rejections - 35 USC § 103

21. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

22. **Claims 15-16 and 18-24** are rejected under 35 U.S.C. 103(a) as being unpatentable over Hollenberg (US Patent Number 6,091,956) in view of the knowledge generally available to one of ordinary skill in the art.

Regarding **claims 15-16**, Hollenberg discloses everything claimed as applied above (see *claim 13*). However, Hollenberg fails to particularly disclose an "IC card" or an "external memory media to be inserted" as claimed by applicant.

The examiner contends that an "external memory media" for storing downloaded information, as well as related information (identification indicia, such as, user number), is conventionally known in the art for the well known advantage of saving memory space in the subject device, or for expanding the capability of storage of the subject device.

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to particularly enable Hollenberg's mobile terminal with the capability of an external memory media for storing downloaded information for the advantage of expanding the capability of storage of the subject device, or for saving memory space in the subject device.

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As better understood, **claims 18-24** are corresponding method claims to apparatus/system *claims 1-17* explained above. Therefore, they are rejected for the same reasons shown above.

Citation of Pertinent Prior Art

23. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

Chern et al. (U.S. Patent Number 6,381,465) see abstract, and Figures 1 and 16;

Indekeu et al. (U.S. Patent Number 5,694,120) see abstract, and Figure 1;

May (U.S. Patent Number 5,715,243) see abstract, and Figures 1, 3, 6;

Murphy (U.S. Patent Number 5,991,690) see abstract, and Figures 3-6;

Pressel et al. (U.S. Patent Number 5,900,825) see abstract, and Figure 1.

Conclusion

24. Any response to this Office action should be mailed to:
Commissioner of Patents and Trademarks
Washington, D.C. 20231

or faxed to:

(703) 872-9314

for formal communications intended for entry, informal communications or draft communications; in the case of informal or draft communications, please label "PROPOSED" or "DRAFT".

Hand-delivered responses should be brought to

Crystal Park II
2121 Crystal Drive
Arlington, VA
Sixth Floor (Receptionist).

25. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eliseo Ramos-Feliciano whose telephone number is (703) 305-0078. The examiner can normally be reached on Monday through Thursday (first week of bi-week) and Monday through Friday (second week of bi-week) from 8:30 a.m. to 6:00 p.m..

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dwayne Bost, can be reached on (703) 305-4778. The fax phone number for this Group is (703) 872-9314.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-4700, or call Group customer service at (703) 306-0377.

ERF/erf
April 20, 2003.

ELISEO RAMOS-FELICIANO
PATENT EXAMINER

Erika Gary
ERIKA GARY
PATENT EXAMINER